



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,292	01/04/2002	Tommy Lee Davis JR.	43016/30480	8425

33649 7590 12/22/2004
Mr. Christopher John Rourk
GODWIN GRUBER, LLP
1201 Elm Street, Renaissance Tower
DALLAS, TX 75270

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,292

Applicant(s)

DAVIS ET AL.

Examiner

Andrew J. Fischer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 21-29 is/are pending in the application.
4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 21-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicants' amendment filed October 4, 2004 is acknowledged. Accordingly, claims 1-5 and 21-29 remain pending.
2. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" refers to examiner(s) generally.
3. This application in an image file wrapper ("IFW") application. Applicant(s)' response is therefore broken down before being placed into the IFW system (*i.e.* claims, remarks, drawings, etc. are separated and independently scanned). To ensure proper handling by the Examiner, the Examiner highly recommends Applicants place the application serial no (*e.g.* 06/123,456) in a header or footer (or other appropriate area) of *each* page submitted. At the very least, the Examiner highly recommends this practice for all pages listing the claims.
4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Restriction

5. Because Applicants have canceled claims 6-20, this patent application no longer contains claims directed to two or more inventions. The restriction as set forth in the Office Action mailed June 2, 2004, Paragraph Nos. 4-12 is hereby withdrawn.

6. However, because newly submitted claims 21-29 are directed to an invention that is independent or distinct from the invention originally claimed, a new restriction to one of the following inventions is usually required under 35 U.S.C. §121:

I. Claims 1-5, drawn to a method of equipment management and identifying assets, classified in class 705, subclass 30.

II. Claims 21-24, drawn to a method of equipment management, classified in class 700 subclass 214.

III. Claims 25-29, drawn to an equipment management system, classified in class 709, subclass 200.

7. It is the Examiner's position that Invention II is not patentably distinct from Invention I and that Invention I is not patentably distinct from Invention II. A restriction between these two inventions would therefor be improper at this time. Should Applicants amend the claims such that the Inventions become patentably distinct, a restriction at that time will be made. See MPEP §811.01.

8. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as

claimed can be practiced by another materially different apparatus—an apparatus that does not include a detector.

9. Because these inventions are distinct for the reasons given above, because these inventions have acquired a separate status in the art as shown by their different classification and divergent subject matter, and because the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

10. Since Applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. §1.142(b) and MPEP §821.03.

11. Applicants are reminded that upon Applicants' cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(i).

Claim Rejections - 35 USC §101

12. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 3-5 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test:

(1) The invention must be within the technological arts; and

(2) The invention must produce a useful, concrete, and tangible result.

14. Prong (1) requires the claimed invention to be within the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280, 289-90 (C.C.P.A. 1970); and *In re Johnston*, 502 F.2d 765, 183 USPQ 172, 177 (C.C.P.A. 1974). Mere abstract ideas (*i.e.*, laws of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts”¹ and are therefore non-statutory subject matter.²

For a process, the claimed process must somehow apply, involve, use, or advance the technological arts. Mere intended or nominal use of a component—albeit within the technological arts—does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In other words, if the invention in the body of the claim is not tied to a technological art, environment, or machine, the claim is non-statutory. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (B.P.A.I. 2001) (Unpublished). See also MPEP §2106 IV B. 2 (b) ii). The Examiner recommends (by way of example only) *positive recitation* of a computer or other technology within the body of the claim if the specification supports such an amendment.

15. Claims 3-5 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. See MPEP

¹ It is the Examiner’s position that “technological arts” is synonymous with “useful arts” as stated in the U.S. Constitution, Art. I, §8. See *In re Waldbaum*, 457 F.2d 997, 173 USPQ 430, 434 (C.C.P.A. 1972).

² *E.g.*, the physical sciences are statutory; *c.f.*, social sciences which are non-statutory

§2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990). Evidence to support an interpretation that Applicants intend to claim a method includes the preamble which states in part, “the improved method comprising” Evidence to support an alternative position that the claims are directed towards a product include Applicants’ statement that that “an equipment management system is clearly patentable subject matter.”³ 35 U.S.C. §101 defines four (4) categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed). Applicants are respectfully requested to state at least one of the four (4) statutory classes Applicants intend claims 3-5 to be drawn under.

Claim Rejections - 35 USC §112 2nd Paragraph

16. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1-5 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

- a. Claims 3-5 are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. It is therefore unclear whether Applicants are claiming a process or a machine. See MPEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

³ Applicants’ Remarks/Arguments filed October 4, 2004, Page 7, ¶3.

b. In claim 1, it is unclear if the “individual profile” in section h. is the same as “an individual profile” in section g. Because Applicants’ use “an” as a prefix to section h.’s “individual profile,” it appears to be separate and independent of section g.’s “individual profile.” Appropriate correction is required.

c. Also in claim 1, it is unclear if step m) will occur since step l) determines if the equipment is an asset. If the equipment is not an asset, step m. will never occur making the scope of claim 1 unclear. Applicants are reminded that “[l]anguage that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]” MPEP §2106 II C.

18. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

Art Unit: 3627

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1-5, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Bowers et. al. (U.S. 6,195,006 B1) ("Bowers '006"). Bowers '006 discloses the claimed invention as previously discussed. Additionally, Bowers '006 the claimed flag setting steps since they are inherent in Bowers '006.

21. Claims 21-24 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Maloney (U.S. 6,232,876 B1).

Claim Rejections - 35 USC §103

22. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-5, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable Bowers '006 in view of Conway (U.S. 5,732,401).⁴ It is the Examiner's principle position that the claims are anticipated because of the inerencies in Bowers

⁴ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

Art Unit: 3627

'006. However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bowers '006 as taught by Conway to include turning on a flag for a given item after the occurrence of a certain event and checking to see if the flag has been turned on. Such a modification would have disclosed known computer programming techniques. Additionally, such a modification would have provided additional information regarding the status of the items when determining whether or not to order new books or other items.

24. Claims 21-24, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable Bowers '006 in view of Conway. Because Invention II (claims 21-24) is not patentably distinct from Invention II (claims 1-5). Therefore the patentability of claims 21-24 stands or falls with Invention I (claims 1-5).

25. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,⁵ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements⁶ with the required clarity, deliberateness, and

⁵ See the Examiner's previous Office Action mailed June 2, 2004, Paragraph No. 23.

⁶ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim

Art Unit: 3627

precision.⁷ Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,⁸ Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants have not argued lexicography is invoked). Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation⁹ to be their own lexicographer.¹⁰ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023,

with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁷ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁸ See again the Examiner's previous Office Action, Paragraph No. 23.

⁹ Id.

¹⁰ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed December 20, 2004).

Art Unit: 3627

1027 (Fed. Cir. 1997).¹¹ The Examiner now relies heavily and extensively on this interpretation.¹² Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

26. It is the Examiner's position that Applicants have elected *not* to recited any product-by-process limitations.¹³

Response to Arguments

27. Applicants' arguments filed October 4, 2004 have been fully considered but they are not persuasive.

28. Regarding the §101 rejections, Applicants that "an equipment management system is clearly patentable subject matter."¹⁴ The Examiner respectfully disagrees. Unless the system produces a useful, concrete, and tangible result and is within the technological are, such methods are not necessarily patentable. Applicants are reminded that "[I]n general, a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim. Conversely, a preamble is not limiting where a patentee defines a

¹¹ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

¹² See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

¹³ See the Examiner's previous Office Action mailed June 2, 2004, Paragraph No. 26.

¹⁴ Applicants' Remarks/Arguments filed October 4, 2004, Page 7, ¶3.

Art Unit: 3627

structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.” *Catalina Marketing International Inc. v. Coolsavings.com Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784-85 (Fed. Cir. 2002) (citations and quotations omitted).¹⁵ It is the Examiner’s position that that preamble in this particular claim does not breathe life and breath to the claim since (other than the §101 rejection), the preamble is not necessarily need to interpret the claim. Moreover, the Examiner finds that the preamble does not add any method steps. “If the body of the claim sets out the complete invention, and the preamble is not necessary to give ‘life, meaning and vitality’ to the claim, ‘then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.’” See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001)(citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1166(Fed. Cir. 1999).

29. It is the Examiner’s position that the body of claim 3 sets out a process while the preamble as argued by Applicants sets out a product. Where the preamble is in direct conflict with the body of the claim, it’s the body of the claim that governs. “The language of the body of the claim ‘sets out the complete invention’ in that it provides in detail the functional attributes of the device that performs the methods.” *Schumer v Laboratory Computer Systems, Inc.*, 308 F.3d 1304, 1310-11, 64 USPQ2d 1832, 1837 (Fed. Cir. 2002) (citations omitted) (rejecting the preamble’s conflicting “and” interpretation in favor of the body’s “or” interpretation). So in this case, it is the body of the claim that governs.

¹⁵ “The preamble of a claim is not necessarily limiting.” *Epcon Gas Systems, Inc. v. Bauer Compressors, Inc.*, 61 USPQ2d 1470, 1475 (Fed. Cir. 2002) (citations omitted).

Art Unit: 3627

30. Regarding the 35 U.S.C. §112 2nd paragraph rejections, Applicants again rely on the preamble. Again the Examiner finds that the preamble in claim 1 is not necessary to give life, meaning, and vitality to the claim.

31. Applicants also state that “there is no relationship at all between the requirements of 35 U.S.C. 101 and 35 U.S.C. §112 2nd paragraph”¹⁶ The Examiner respectfully disagrees. For example see MPEP §2173.05(p) II noting that both a §101 and a §112 2nd paragraph are required for hybrid claims. Additionally, a claim may have a §101 problem and a §112 1st paragraph problem. “A claimed invention having an inoperable or impossible claim limitation may lack utility under 35 U.S.C. §101 and certainly lacks an enabling disclosure under 35 U.S.C. §112.” *EMI Group North America, Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423, 1427 (Fed. Cir. 2001) (citations omitted); *In re Swartz*, 232 F.3d 862, 863, 56, USPQ2d 1703, 1704 (Fed. Cir. 2000) (citations omitted) (“Thus, if the claims in an application fail to meet the utility requirement because the invention is inoperative, they also fail to meet the enablement requirement because a person skilled in the art cannot practice the invention.”); and *Process Control Corp. v. Hydrex Corp.*, 190 F.3d 1350, 1359, 52 USPQ2d 1029, 1035 (Fed. Cir. 1999) (“Moreover, when a claim requires a means for accomplishing an unattainable result, the claimed invention must be considered inoperative as claimed and the claim must be held invalid under either Section 101 or Section 112 of 35 U.S.C.”).

¹⁶ Applicants’ Remarks/Arguments filed October 4, 2004, Page 9, ¶2.

Art Unit: 3627

32. Regarding the 35 U.S.C. §112 2nd paragraph rejection for claim 5, In particular, it is unclear if the “obtaining” and “matching” steps are ‘in replacement of’ or ‘in addition to’ the “making” step in claim 4. Moreover, it is axiomatic that if interpreted to be ‘in replacement of,’ such an interpretation would fail the “Infringement Test” as noted in MPEP §608.01(n) III.

After review of all the evidence of record and because of the lack of evidence to the contrary, the Examiner adapts the presumption that the term “wherein” connotes a different meaning than the term “further comprising.” See *CAE Screenplates Inc. v. Heinrich Fielder GmbH & Co. KG*, 224 F.3d 1308, 1317, 55 USPQ2d 1804, 1810 (Fed. Cir. 2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”).¹⁷

With this presumption and because Applicants use “further comprising” in *e.g.* claim 4, the Examiner concludes that claims which *do not* recite ‘further comprising’ are presumed to have a meaning other than ‘further comprising.’ In particular, if Applicants intended the phrase “wherein” in claim 5 to be *in addition to*, Applicants would have also recited ‘further comprising’ or similar language in claim 5 just as they did in claim 4. In other words, had Applicants actually meant ‘further comprising’ in claim 5, they would have used those words.¹⁸

¹⁷ See also *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987) (noting that the meaning of claim terms must be defined in a manner that is consistent with its appearance in other claims in the same patent).

¹⁸ See *e.g. International Rectifier Corp. v. IXYS Corp.*, 70 USPQ2d 1209, 1217 (Fed. Cir. 2004) (where the Federal Circuit reversed the district court’s determination that ‘adjoining’ was synonymous with ‘adjacent.’ “Had the inventor meant ‘adjacent,’ he could have used that word.”)

Art Unit: 3627

However as of the date of this Office Action, Applicants have chosen not to recite 'further comprising' or similar claim language in claim 5. Therefore claim 5 is indefinite because it fails to further limit claim 4.

33. As noted above, Applicants have not overcome the §101 and §112 2nd paragraph rejections.

34. Regarding Applicant's discussion of Bowers '006, Applicants allege that Bowers '006 does not disclose the turning and determining steps. The Examiner respectfully disagrees. The claimed use of flags is old and well known in computer programming.

35. Applicants' remaining arguments have been considered but are not persuasive.

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3627

37. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

38. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

40. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference Introduction to Financial Accounting, Revised 3rd Ed. by Horngren et. al. ("Horngren") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that Horngren describes basic financial accounting practices permitting the user to obtain a thorough grasp of the fundamentals of accounting. The reference is cited in its entirety. Moreover, because the reference is a introductory accounting textbook that presupposes no prior knowledge of accounting, because of the reference's basic content which is self evident upon review of the reference, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner

Art Unit: 3627

finds that Horngren is primarily directed towards those of low skill in this art. Because Horngren is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within Horngren.

41. Also in accordance with *In re Lee*, 2277 F.3d at 1344-45, 61 USPQ2d at 1434-35, the Examiner finds that the Borland's Paradox for Windows User's Guide is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The reference is cited in its entirety. Paradox for Windows User's Guide exemplifies a typical relational database system. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Paradox for Windows User's Guide is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the reference.

42. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a

Art Unit: 3627

claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

43. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their “Remarks/Arguments” (beginning on page 7) traversing the Examiner’s positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁹ the Examiner respectfully reminds Applicants to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner’s positions or have other questions regarding this communication or even previous

Art Unit: 3627

communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
December 20, 2004

¹⁹ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.